



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,181	02/07/2002	Jae Duck Kim	9794440-1000	1291

26263 7590 11/24/2004

SONNENSCHN NATH & ROSENTHAL LLP
P.O. BOX 061080
WACKER DRIVE STATION, SEARS TOWER
CHICAGO, IL 60606-1080

EXAMINER

DICUS, TAMRA

ART UNIT PAPER NUMBER

1774

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/072,181

Applicant(s)

KIM, JAE DUCK

Examiner

Tamra L. Dicus

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 and 62-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38, 62-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The 103 rejection is withdrawn due to Applicant's argument of identical images.

Acknowledgment is made of cancellation of claims 39-61.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-5, and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,262,215 to Shields.

Shields teaches the following: a top layer 16 includes top sheet 20 composed of paper having indicia 22 (another/other image)) imprinted on top surface 24 thereof and also includes low tack, semi-permanent, pressure sensitive adhesive 26 on bottom surface 28 thereof. Additionally, top layer 16 is preferably die cut in order to present a plurality of separable "stickers" or pieces 30 within matrix 32 (equivalent to "adhesive is formed in a shape similar to image"). Indicia 22 are configured in a manner to cooperate with indicia 42 (image) imprinted on carrier sheet 14. Pieces 30 form an exemplary illustration, as best seen in FIG. 4, representing humorous facial features for cooperative placement on the corresponding facial outline seen as the indicia 42 imprinted on carrier sheet 14. A wide variety of indicia for pieces 30 and sheet 14 which can include, for example, game components for tic-tac-toe or checkers, or components to create a scene in cooperation with indicia on sheet 14. Support layer 18 is

Art Unit: 1774

preferably release paper and includes support sheet 34 composed of paper having release coating 36 on upper surface 38 thereof. Adhesive 26 releasably adheres bottom surface 28 and thereby top layer 16 to upper surface 38 of support layer 18. See col. 2, lines 3-30. Carrier 14 of paper includes a release coating 44. At, col. 2, line 35 and col. 3, line 14 releasing coating/agent is known to be of silicon.

Regarding claims 3-5 and 8 the process limitations "is formed by a silk screen process" and "is printed on the surface by offset printing..." are not dispositive of the issue of patentability of the present article claims.

At col. 2, line 42, carrier 14 comprises a water based resin polyvinyl acetate, inclusive of an acrylic acid ester polymer (meeting claims 7, 9, 10).

Shields already provides for the same structure as claimed, but Shields does not teach identical images that coincide. However, it would have been obvious to reprint the same indicia as the mere duplication of parts has no patentable significance unless a new and unexpected result is produced. Further it would have been obvious to have modified the images as claimed depending on the design and desired placement to effect the coverage area. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272.

2. Claims 6, and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,262,215 to Shields in view of USPN 6,110,317 to Sandor.

Shields is relied upon above. Shields does not teach a plurality of base layers. Sandor teaches a decorative design method and product. The identical images are shown in Figures 2, 10F and 12F, see also col. 8, lines 20-23 where Sandor explains the two images coincide with

each other on a surface. However Sandor teaches a decorative design method and product may comprise a plurality of base layers in order to provide an unique dimensional effect at col. 6, lines 32-43. Therefore, it would have been obvious to one of ordinary skill in the art to modify the laminated article of Shields to further include a plurality of base sheets since Sandor teaches doing so provides an unique dimensional effect as cited above.

Shields does not teach a base layer being either transparent or opaque (claims 11-12). However, Sandor teaches where base layers such as release paper may be of clear plastic webs (equivalent to transparent base layer) and may also be opaque at col. 3, lines 27-30. Therefore it would have been obvious to one of ordinary skill in the art to modify the laminated article of Shields to include transparent or opaque base layers since Sandor teaches the two types are conventional release papers as cited above.

3. Claims 13-17, 19-22, 25-31, 33-36, and 62-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,262,215 to Shields.

4. Shields teaches the following: a top layer 16 includes top sheet 20 composed of paper having indicia 22 (another/other image)) imprinted on top surface 24 thereof and also includes low tack, semi-permanent, pressure sensitive adhesive 26 on bottom surface 28 thereof. Additionally, top layer 16 is preferably die cut in order to present a plurality of separable "stickers" or pieces 30 within matrix 32 (equivalent to "adhesive is formed in a shape similar to image"). Indicia 22 are configured in a manner to cooperate with indicia 42 (image) imprinted on carrier sheet 14. Pieces 30 form an exemplary illustration, as best seen in FIG. 4, representing humorous facial features for cooperative placement on the corresponding facial outline seen as the indicia 42 imprinted on carrier sheet 14. A wide variety of indicia for pieces 30 and sheet 14

Art Unit: 1774

which can include, for example, game components for tic-tac-toe or checkers, or components to create a scene in cooperation with indicia on sheet 14. Support layer 18 is preferably release paper and includes support sheet 34 composed of paper having release coating 36 on upper surface 38 thereof. Adhesive 26 releasably adheres bottom surface 28 and thereby top layer 16 to upper surface 38 of support layer 18. See col. 2, lines 3-30. Carrier 14 of paper includes a release coating 44.

At, col. 2, line 35 and col. 3, line 14 releasing coating/agent is known to be of silicon (meeting claims 14 and 28).

5. Regarding claims 15-17, 20, 29-31, and 34, the process limitations “is formed by a silk screen process” and “is printed on the surface by offset printing...” are not dispositive of the issue of patentability of the present article claims.

6. At col. 2, line 42, carrier 14 comprises a water based resin polyvinyl acetate, inclusive of an acrylic acid ester polymer (meeting claims 19, 21-22, 33, 35-36).

7. Regarding claim 13, Shields teaches an image (22) on a decal (52) on an image (42), on a surface 44/56 (base layer) in Figure 4 (equivalent to Applicant's Figure 2 and claims 13 and 25). While the shape is not similar/identical and Shields does not expressly state the images “coincide”, Shields teaches the indicia may incorporate graphics and text, which it would have been obvious to reprint the same indicia as the mere duplication of parts has no patentable significance unless a new and unexpected result is produced. Further it would have been obvious to have modified the images as claimed depending on the design and desired placement to effect the coverage area. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272. The decal (52) is

Art Unit: 1774

comprised of release paper, adhesive, and a base layer (instant claims 62-67) see Figure 4 of Shields.

8. Claims 18, 23-24, 32, and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,262,215 to Shields in view of USPN 6,110,317 to Sandor.

Shields essentially teaches the claimed invention. Regarding claims 18 and 32, Shields does not teach the sheet comprises a plurality of base layers. However, Sandor teaches a decorative design method and product may comprise a plurality of base layers in order to provide an unique dimensional effect. The base layers contain a first and second design on each release sheet. See col. 6, lines 32-43. Therefore, it would have been obvious to one of ordinary skill in the art to modify the laminated article of Shields to further include a plurality of base sheets having designs since Sandor teaches doing so provides an unique dimensional effect as cited above.

Shields does not teach a base layer being either transparent or opaque (claims 23, 24, 37, 38). However, Sandor teaches where base layers such as release paper may be of clear plastic webs (equivalent to transparent base layer) and may also be opaque at col. 3, lines 27-30. Therefore it would have been obvious to one of ordinary skill in the art to modify the laminated article of Shields to include transparent or opaque base layers since Sandor teaches the two types are conventional release papers as cited above.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection. The Examiner has considered Applicant's arguments and understands that a decal with image (102) is peeled off to reveal the exact same image underneath (200) as in Applicant's

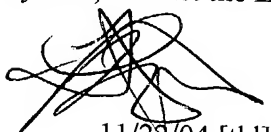
Art Unit: 1774

Figure 102 illustrates, however, Shields provides the exact same structure minus the shape of the image/adhesives. Now the rejection above reflects that this difference is an obvious difference in view of the Shields reference as a difference in design, placement, and mere duplication of the same thing is not a patentable difference. See MPEP 2144.04 (B). Mere duplication of parts has no patentable significance unless a new and unexpected result is produced. Shields is still used in the rejection to provide for the essential structure of the instant decal. Sandor is still used in the rejection to teach multiplicity of base layers and their opacity level-transparent or opaque.

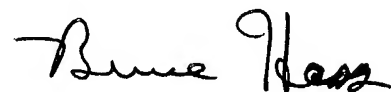
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



11/22/04 [tld]



BRUCE H. HESS
PRIMARY EXAMINER